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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Hubert GRANGE et al.

Group Art Unit: 2811

Application No.: 10/567,865

Examiner: T. TRAN

Filed: February 10, 2006

Docket No.: 126997

For: MICRO-MECHANICAL DEVICE COMPRISING A SUSPENDED ELEMENT
WHICH IS CONNECTED TO A SUPPORT BY MEANS OF A PIER, AND
PRODUCTION METHOD THEREOF

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the June 10, 2009 Election of Species Requirement, Applicants
provisionally elect Species VI, Figures 19, with traverse.

Applicants further assert that at least claims 1 and 7-10 read on the elected species,
and that claim 1 is generic to all species.

However, this Election of Species Requirement is strongly traversed since it is
contrary to PCT rules, which are applicable in this National Phase application. For example,
Article 27 of the Patent Corporation Treaty requires that "no national law shall require
compliance with requirements relating to the form or contents of the international application
different from or in addition to those which are provided for in this Treaty and the
regulations."

Further, PCT Rule 13 requires that claims that encompass one single general inventive
concept be searched and examined in the same international application. For example, PCT

Rule 13.1 states: "the international application shall relate to one invention or to a group of inventions so linked as to form a single general inventive concept."

Furthermore, PCT Rule 13.4 expressly states that: "subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention."

The Election of Species Requirement is a convention specific to U.S. National Patent Application Examination practice. PCT Rule 13.1 specifically contemplates the single examination of a group of inventions so linked as to form a single general inventive concept, and PCT Rule 13.4 specifically requires examination of species claims within a single general inventive concept. Nothing in the PCT or its rules permits issuing an Election of Species Requirement. Any United States practice (such an Election of Species Requirement) or interpretation of the rule which is different from or in addition to the unity of practice as delineated in PCT Unity Rules 13.1-13.4 is necessarily in violation of PCT Article 27. Species practice is not provided for under PCT Rules 13.1-13.4 and is contrary to PCT Article 27, and the present Election of Species Requirement is accordingly prohibited by Article 27.

Additionally, unity of invention only needs to be determined in the first place between independent claims, and not the dependent claims, as stated in ISPE 10.06:

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (Rule 6.4).

See also MPEP §1850(II). ISPE 10.07 further provides:

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

See also MPEP §1850(II).

Applicants respectfully submit that all claims variously depend from claim 1 and, thus, claim 1 is the only independent claim. Accordingly, because claims 2-10 require all the features of claim 1, there can be no lack of unity under the PCT rules unless the general inventive concept shared by all the claims (i.e., the features of claim 1) can be found in the art. The Election of Species Requirement makes no assertion that the general inventive concept common to all the claims has been found in the art and, thus, lack of unity under the PCT Rules has not properly been established.

Thus, withdrawal of the Election of Species Requirement is respectfully requested.

Respectfully submitted,



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